

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT PAUL CASSONI and ALAN HARDY BAILEY

Appeal No. 2003-1475
Application No. 09/352,250

HEARD: NOVEMBER 19, 2003

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 4, 6 through 13, and 15 through 19, all of the claims remaining in the application.

Appellants' invention pertains to a book clamp for a book binding machine. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the Appendix to the brief (Paper No. 17).

Appeal No. 2003-1475
Application No. 09/352,250

As evidence of obviousness, the examiner has applied the documents listed below:

Brenner	3,633,727	Jan. 11, 1972
Rathert	4,467,912	Aug. 28, 1984

The following rejections are before us for review.

Claims 16 and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification at the time the application was filed.

Claims 7 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 4, 6 through 10, 13, and 15 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of Rathert.

Appeal No. 2003-1475
Application No. 09/352,250

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 18), while the complete statement of appellants' argument can be found in the brief (Paper No. 17).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,¹ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appeal No. 2003-1475
Application No. 09/352,250

Description issue

We do not sustain the rejection of claims 16 and 19 under 35 U.S.C. § 112, first paragraph.

Claims 16 and 19 were added to the application subsequent to the filing thereof.²

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d

² The description in the specification should comport with the language of claims 16 and 19, as required by 37 CFR 1.75(d)(1). This matter should be addressed following this decision.

Appeal No. 2003-1475
Application No. 09/352,250

1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner is of the view that the claim limitation specifying that a portion of the first flexible spring plate overlaps the overlap portion of a second flexible spring plate has not been clearly disclosed in the specification, i.e., with reference to Fig. 5, it is not clear how the first flexible spring plate overlaps the overlap portion of the second flexible portion.

We certainly appreciate the examiner's point of view in this matter (answer, pages 3, 7 and 8). However, we do not reach the same conclusion. On the basis of the showing in Figs. 5 and 6 and the disclosure in the specification (pages 6 through 8), it is our opinion that one skilled in the art at issue would readily understand that portions of the first and second flexible spring plates 34, 36 overlap one another to enable the plates to be secured to the spring plate 18 by means of the plurality of fasteners 32 (Fig. 5). Thus, appellants' original disclosure is determined to be clear and supportive of the claim content of concern to the examiner since it would reasonably convey to an

Appeal No. 2003-1475
Application No. 09/352,250

artisan that appellants had possession at the time of filing of the present application of the later claimed subject matter of claims 16 and 19. It is for this reason the rejection under 35 U.S.C. § 112, first paragraph, cannot be sustained.

Indefiniteness issue

We do not sustain the rejection of claims 7 and 9 under 35 U.S.C. § 112, second paragraph, as being indefinite.

In the examiner's opinion, the recitation of a second clamp member "adapted to" a first clamp member in a claim to a book clamp raises an issue of indefiniteness. We disagree. Clearly, the "adapted to" language establishes a very broad relationship between the first and second clamp members. Nevertheless, in our opinion, this broad relationship between clamp members of a book clamp would be understood by one skilled in the art, based upon the underlying disclosure. Thus, the language at issue is certainly very broad, but not indefinite in meaning. As such, the indefiniteness rejection cannot be sustained.

Obviousness issues

We do not sustain the rejection of claims 1 through 4, 6 through 10, 13, and 15 through 19 under 35 U.S.C. § 103(a) as being unpatentable over Brenner.

Independent claim 1 sets forth a book clamp for a book binding machine including the feature of a flexible spring plate connected to a second clamp member and defining a concave surface facing a first clamp member. Independent claim 7 addresses the feature of a flexible spring plate with a cross sectional shape of a polygon. Independent claims 9, 15 and 16 set forth the feature of plural flexible spring plates.

The patent to Brenner teaches a clamping part or feeding surface 16 preferably provided with a resilient material or pillow 25. As depicted, a single pillow 25 has a convex surface facing a perpendicular plate 13. As recognized by the examiner, Brenner clearly lacks a concave surface of a flexible spring plate facing a first clamp member, a flexible spring plate with a cross sectional shape of a polygon, and first and second flexible

Appeal No. 2003-1475
Application No. 09/352,250

spring plates. Nevertheless, the examiner concludes on the basis of the Brenner teaching alone that the claimed book clamp would have been obvious. We disagree. It is very clear to this panel of the Board that only impermissible hindsight and reliance upon appellants' own teaching would have enabled one having ordinary skill in the art to derive the claimed invention from the Brenner teaching by itself. Brenner would not have provided any suggestion whatsoever for the modifications thereof proposed by the examiner. Thus, the specified obviousness rejection cannot be sustained.

We do not sustain the rejection of claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of Rathert.

Like appellants (brief, page 22), we readily perceive that the teaching of Rathert does not overcome the noted deficiency of the Brenner disclosure. Thus, we cannot sustain this obviousness rejection of claims 11 and 12.

Appeal No. 2003-1475
Application No. 09/352,250

In summary, this panel of the board has not sustained any of the examiner's rejections on appeal.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Appeal No. 2003-1475
Application No. 09/352,250

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